

Application No.: 09/871,605
Attorney Docket No.: 010713
Amendment under 37 CFR §1.116

REMARKS

Claims 1, 3-7 and 9-12 are pending in the present application. Claims 1 and 7 are herein amended.

Claim Rejections - 35 U.S.C. § 112

Claims 1, 3-7 and 9-12 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office Action states that it is unclear whether claim 1 claims “performing an examination operation” or “setting of examination requirements by a human operator.” Similarly, the Office Action states that it is unclear whether claim 7 claims “registration of information about applicants passing an examination into a membership database” or “setting of examination requirements by a human operator.”

Regarding claim 1, Applicant respectfully submits that claim 1 is definite. Claim 1 recites that the step of “performing examination operation,” and the claim further defines the examination operation by reciting that the examination operation is “based on examination requirements set by a human operator.”

Regarding claim 7, the phrase which recites that “the examination is based on examination requirements set by the human operator” has been moved with the limitation which defines the “means for performing an examination” to provide clarification.

Withdrawal of the rejections under § 112 is requested.

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Claim Rejections - 35 U.S.C. § 103

Claims 1, 3-7 and 9-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over **Eisenhart** (U.S. 2001/0047276) in view of **Stephanous** (US 6,513,013) and **Dworkin** (U.S. 6,026,148). Favorable reconsideration is requested.

Claims 1 and 7 have been amended to further distinguish Eisenhart in view of Stephanous and Dworkin. The amended claims clarify that the human operator is not an intermediary, but rather part of the corporation that desires engineering information. Specifically, claims 1 and 7 have been amended to recite that it is the corporation that desires engineering information that solicits members, causes an applicant to report predetermined items, performs examination operation (by way of the human operator), selects members for which provision of information is to be requested, requests the selected members to offer engineering information, and accumulates the information.

Applicant notes that in the present invention, when a certain company wants to effectively gather technical information, the company can register an applicant having technical knowledge that the company needs and initiate contact with the registered applicant in accordance with the company's strategy. On the other hand, in the cited references, a certain company cannot effectively gather information in accordance with the certain company's strategy because the database is openly constructed.

(1) Applicant respectfully submits that Eisenhart in view of Stephanous and Dworkin does not teach or suggest a method or system in which an information requester directly seeks out information from members without the use of an intermediary, and it would not have been

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obvious in view of Stephanous and Dworkin to remove the intermediary technology exchange system 110 from Eisenhart since collaboration system of Eisenhart would be inoperable without the technology exchange system.

The technology exchange system 110 of Eisenhart acts as the facilitator or intermediary between a technology supplier 120 and a buyer of a technology asset 130. This is consistent with the Office Action's statement of official notice that "it is well-known in the art for an intermediary to match service requesters with service providers." (Office Action, page 8.) However, the Office Action also incorrectly asserts that the "human operator" as recited in the claims corresponds with an "intermediary" to match "users" with "experts."

The primary reference, Eisenhart, discloses a system in which a technology exchange system 110 facilitates the collaboration between a technology supplier 120 and a buyer of a technology asset 130. (*See, e.g.*, paragraphs 10-14.) The technology exchange system 110 provides information to potential members and provides a platform for a potential member to register. The technology exchange system 110 stores the registration data, analyzes the registration data to verify qualifications, creates an account for members that satisfy the qualification criteria, and creates a profile for the member. (Paragraphs 105-106.) Members can browse a directory listing of member and project profiles on the technology exchange system 110, or the technology exchange system 110 can recommend other members that are likely to be a good match for a technology exchange based on a "need profile." (Paragraph 14.) A member can then request direct contact with one of the "good matches" determined by the technology exchange system to complete the business deal and transfer information. (Paragraph 14.)

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The “human operator” as recited in the claims is not an “intermediary” as asserted by the Office Action and Eisenhart does not teach or suggest a system in which an information requester directly seeks out information from members without the use of an intermediary.

(2) Applicant also respectfully submits that one of ordinary skill in the art at the time of the present invention would not have been motivated to combine the teachings of Eisenhart and Dworkin.

The Office Action takes the position that Eisenhart and Dworkin are linked through their mutual teachings of selecting specific participants for collaboration in exchanging information. The Office Action states that the references contain similar features for matching prospective candidates for collaborative information exchange. The Office Action further states that the references contain similar features for matching prospective candidates for collaborative information exchange.

However, Applicant notes that a determination of obviousness is based on the references as a whole. MPEP § 2141(II). The Office Action focuses only on similarities between Eisenhart and Dworkin for supporting the assertion that there is motivation to combine the references, and not the references as a whole.

Dworkin discloses a computer bulletin board or forum for posting questions in which a respondent expert then answers. (Abstract.) By contrast, Eisenhart is concerned with forming business partnerships. (Eisenhart, paragraph 14.) Eisenhart discloses facilitating collaboration between a technology supplier and a buyer of a technology asset. (Abstract.) Since Dworkin

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and Eisenhart deal with unrelated and non-analogous technologies, one of ordinary skill art would not have been motivated to combine the references.

Moreover, Dworkin teaches away from using an intricate computer network as disclosed in Eisenhart. Dworkin discloses a disadvantage in the art of computer-based bulletin boards is that

when one relies on a number of technical experts, these experts must all have some facility with computers, and must be located near a computer, in order to answer questions.

(Col. 1, lines 45-50.) Dworkin discloses solving this problem by

providing a system and method for dissemination of information, especially expert information, wherein the experts providing the information need not be computer literate, and need not be located near a computer.

(Col. 1, lines 59-63.) Specifically, Dworkin discloses solving the problem by providing the expert respondent a way to answer questions by speaking the answer in a telephone. (Col. 2, lines 12-14.) Since Dworkin teaches away from using an intricate computer network as disclosed in Eisenhart, one of ordinary skill in the art would not have been motivated to combine the references.

For at least the foregoing reasons, claims 1 and 7 are patentable over the cited references, and claims 3-6 and 9-12 are patentable by virtue of their dependence from either claim 1 or 7. Accordingly, withdrawal of the rejection of claims 1, 3-7 and 9-12 is hereby solicited.

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In view of the aforementioned amendments and accompanying remarks, Applicant submits that the claims, as herein amended, are in condition for allowance. Applicant requests such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicant's undersigned attorney to arrange for an interview to expedite the disposition of this case.

If this paper is not timely filed, Applicant respectfully petitions for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,
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